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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/943,064 08/31/2001 Nestor M. Benavides GRAY018/00US 8687

22903 7590 12/11/2003

COOLEY GODWARD LLP

ATTN: PATENT GROUP

11951 FREEDOM DRIVE, SUITE 1700

ONE FREEDOM SQUARE- RESTON TOWN CENTER

RESTON, VA 20190-5061

EXAMINER

DANG, HUNG XUAN

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/943,064

Applicant(s)

BENAVIDES ET AL.

Examiner

Hung X Dang

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 22-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 22-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The amendment filed on 8/19/03 has been entered.

Claims Rejection Under 35 USC – 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-29 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention **Kanda** (5,187,504).

Kanda discloses eyeglass frame having hollow adjustable connector which comprises a face having a first end portion, the first end portion including a first contact portion and a second contact portion; a temple pivotably coupled to the first end portion of the face about a pivot axis, the temple being movable between a folded configuration and an unfolded configuration, a portion of the temple contacting the first contact portion of the face when in the unfolded configuration, the portion of the temple contacting the second contact portion of the face when in the folded configuration; and a tension member coupled to the face and the temple, the tension member configured to bias the temple relative to the face while in one of the folded configuration and the unfolded configuration.

Claims Rejection Under 35 USC - 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 22-26 and 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kazuyoshi** (JP 2001-004961, see IDS filed 9/28/01)

Kazuyoshi discloses rimless for holding the lens and the temple connected to the lens, whereby the outer face of the lens is disposed between the inner surface of the lens and the first temple while in the folded configuration. The difference between the claimed invention and Kazuyoshi is: the claimed invention claims the eyeglasses with frame while the Kazuyoshi disclose the frameless eyeglasses.

Eyeglasses have long been designed with the general objective of protecting the eye of the wearer or correcting the vision of the wearer. Numerous designs of eyeglasses with frame and eyeglasses without frame have been developed, differing only in aesthetic feature. Therefore it would have been obvious to one skilled in the art to make the eyeglasses, of the Kazuyoshi, frame or frameless for the purpose of providing aesthetic feature.

It should be noted that although claims 30-39 are "method claims", the method steps consist of the broad steps of "pivoting", and "positioning" etc and therefore these steps would be obvious satisfied by the apparatus of the reference as modified.

Response To Applicant Argument

3. Applicant's arguments filed 8/19/03 have been fully considered but they are not persuasive.

Applicant argued at pages 14 and 15 of the remarks that "the Kazuyoshi publication fails to teach or suggest that at least a portion of the outer side of the both lenses are disposed between the inner side of each lens and the temple as recited in independent claim 1." This argument is not persuasive because figures 2 and 3 of Kazuyoshi clearly show a portion of the outer side of the both lenses (4) are disposed between the inner side of each lens (4) and the temple (1). Thus the claimed invention does not distinguish over the Kazuyoshi device.

Applicant argued at page 15 of the remarks that "As discussed above, the Kazuyoshi publication fails to disclose positioning the temple so that at least a portion of the outer side of each lens is disposed between the inner side of each lens and the temple. Thus, the invention as recited by independent claim 34 and its dependent claims is not disclosed in or suggested by the Kazuyoshi publication." This argument is not persuasive because figures 2 and 3 of Kazuyoshi clearly show a portion of the outer side of the both lenses (4) are disposed between the inner side of each lens (4) and the temple (1). Thus the claimed invention does not distinguish over the Kazuyoshi device.

Applicant argued at pages 15 and 16 of the remarks that "The Kazuyoshi publication fails to teach or suggest "at least a portion of the outer side of the first lens opening portion being disposed between the inner side of the first lens opening portion and the first temple while in the folded configuration and the second lens opening portion being disposed between the inner side of the second lens opening portion and the first temple while in the folded configuration" as recited in independent claim 7." This argument is not persuasive because figures 2 and 3 of Kazuyoshi clearly show a portion of the outer side of the both lenses (4) are disposed between the inner side of each lens (4) and the temple (1). Thus the claimed invention does not distinguish over the Kazuyoshi device.

Applicant argued at page 16 of the remarks that "As discussed above, the Kazuyoshi publication fails to disclose pivoting a temple so that at least a portion of the outer side of the second lens is disposed between the inner side of the second lens and a portion of the temple while in the folded configuration" Thus, the invention as recited by independent claim 30 and its dependent claims is not disclosed in or suggested by the Kazuyoshi publication." This argument is not persuasive because figures 2 and 3 of Kazuyoshi clearly show a portion of the outer side of the both lenses (4) are disposed between the inner side of each lens (4) and the temple (1). Thus the claimed invention does not distinguish over the Kazuyoshi device.

Applicant argued at page 16 of the remarks that "the Kazuyoshi publication does not disclose or suggest any elevated structure disposed on the face whatsoever that is configuration to retain either of the temples. Thus, the invention as recited by

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independent claim 22 and its dependent claims is not disclosed or suggested by the Kazuyoshi publication." This argument is not persuasive because figures 1, 4 and 7 show the temple (1) in the folded configuration being removably retained by the elevated structure of the face on the outer surface of the face. Thus the claimed invention does not distinguish over the Kazuyoshi device.

Applicant argued at page 17 of the remarks that "The Kazuyoshi publication fails to disclose or suggest such a configuration. As discussed above, the Kazuyoshi publication fails to disclose or suggest a configuration in which the temple is positioned so that the outer side of the first lens is disposed between the inner side of the first lens and the temple while in the folded configuration, and at least a portion of the outer side of the second lens is disposed between the inner side of the second lens and the temple while in the folded configuration" This argument is not persuasive because figures 2 and 3 of Kazuyoshi clearly show a portion of the outer side of the both lenses (4) are disposed between the inner side of each lens (4) and the temple (1). Thus the claimed invention does not distinguish over the Kazuyoshi device.

4. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

12/03


HUNG DANG

PRIMARY EXAMINER

TC 2800